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10/085,713	02/28/2002	Jeffrey Scott Weaver	10010089-1	1736

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EXAMINER

RUDOLPH, VINCENT M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/085,713	WEAVER, JEFFREY SCOTT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vincent Rudolph	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 February 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: page 14, line 11 of the specification incorrectly identify “printing device 110” and “feature-enabling information 120”. Please identify them according to Figure 8 of the drawings as – printing device 810– and –feature-enabling information 820–.

Appropriate correction is required.

### ***Double Patenting***

Claims 1, 10-13, 16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-13 and 20 of copending Application No. 09/998,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim about printing for authorized users.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 1 of the applicant, claim 1 of the copending application discloses receiving information corresponding to an authorized user, which is identified as the second information. The second information refers to corresponding to the authorization of the user (See Page 2, Paragraph 0029).

The copending application claims receiving information to be printed and first information corresponding to a user through a computer network. Some of the limitations are not claimed in claim 1 of the current application, but it would have been

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obvious to remove these limitations, such as receiving it through a computer network, in order to obtain the invention claimed in claim 1 of the current application as long as the remaining elements operate in the same manner, which is to have the information for designating a first feature of the printing device enabled. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

The copending application also claims comparing the first and second information and printing of the information is done if the second information corresponds to the first, as well as discontinuing the printing if receipt of the second information is interrupted during printing of the information. It would have been obvious to remove discontinuing limitation in order to obtain the invention claimed in claim 1 of the current application as long as the remaining elements operate in the same manner, which by doing this retrieves the information, and if authorized, enables the printing to continue. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Regarding claim 10 of the applicant, claim 9 of the copending application discloses a printing device having a first print cartridge and an identification reader. The copending application also discloses a transmitter readable identification tag for providing first information. This limitation is not claimed in claim 10 of the current application. However it would have been obvious to remove the transmitter in order to obtain the invention claimed in claim 1 as long as the remaining element operates in the same manner. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

The copending application also claims a print authorization system communicating with the printing device that receives information to be printed and first

information corresponding to a user through a communication network. Further, it discloses it receives third information, which is retrieving the information to enable the printing device to print.

It would have been obvious to remove receiving the information via a communication network, which by doing so, still gets the information needed to authorize the user to print the requested document. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Regarding claim 11 of the applicant, claim 10 of the copending application discloses having an identification reader with a receiver for the information corresponding to the authorization of the user, which is identified as first and third information (See Page 1, Paragraph 0007 and 0008), via wireless communication.

Regarding claim 12 of the applicant, claim 11 of the copending application discloses that the identification reader includes means for receiving information via wireless communication

Regarding claim 13 of the applicant, claim 12 of the copending application discloses a user identification tag, which includes a memory, adapted to communicate with the identification reader via wireless communication. Since a user identification tag is used to correctly identify and authorize a user to print, it is related to the applicant, which discloses a user authorization tag.

The copending application also discloses having the memory store the data corresponding to the third information, which the user identification tag being enabled to provide this information to the reader. Since the third information corresponds to the

authorization of the user (See Page 1, Paragraph 0008), both provide the same data stored to the memory.

Regarding claim 16 of the applicant, claim 13 of the copending application discloses a second print cartridge having, or containing, a print substance for printing on a print medium and a readable identification tag for providing the first information.

Regarding claim 18 of the applicant, claim 20 of the copending application discloses a computer readable medium with logic configured to receive information to be printed with the authorization of the user, which is identified as the first and second information (See Page 1, Paragraph 0007 and 0008). The copending application also claims to receive information relating to designating a first feature the user wants to enable, such as the receive information desires to be printed.

The copending application also claims comparing the first and second information and printing of the information is done if the second information corresponds to the first, as well as discontinuing the printing if the second information is not received during printing of the information. It would have been obvious to remove discontinuing limitation in order to obtain the invention claimed in claim 1 of the current application as long as the remaining elements operate in the same manner, which by doing so, retrieves the information, and if authorized, enables the first feature of the printing device, such as printing the information. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Claims 1-2, 5-7, 9-11, 13-16 and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-10, 13-15 and 18 of U.S. Patent No. 6,694,115. Although the conflicting claims are

not identical, they are not patentably distinct from each other because they both disclose printing for authorized users.

Regarding claim 1 of the applicant, claim 1 of the patent discloses a method for altering a configuration of a printing device, which is the same as enabling features. Enabling a feature is considered to be a change in the printer's configuration. The patent also discloses receiving the information corresponding to an authorization of the user, with a configuration, or feature, the user desires to enable or exhibit. The feature or configuration is granted once the information is received

The patent also claims providing a user authorization tag with information to the authorization of the user within a proximity of the printing device, but it would have been obvious that information is already received if the user desires to print a document. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Also, the applicant discloses retrieving the information to enable the first feature, although if the information was already received, it also contained the information to enable the first feature, or exhibit the first configuration.

Regarding claim 2 of the applicant, claim 7 of the patent discloses receiving information to be printed as well as enabling the printing device to print the information using the first feature, or configuration.

Regarding claim 5 of the applicant for getting the information to enable the first feature, or configuration, claim 2 of the patent discloses a method for accessing an external storage medium, which is outside to the printing device, and retrieving the

information adapted to enable to the first configuration, or feature, from the storage medium.

Regarding claim 6 of the applicant, claims 3 and 4 of the patent discloses a method that the storage medium is a web server, which is a web site used to store and retrieve the needed information.

Regarding claim 7 of the applicant, claim 4 of the patent discloses a method that provides a web site with the web server, which is a storage medium for retrieving the information needed to enable the desired feature or configuration.

Regarding claim 9 of the applicant, claim 5 of the patent discloses a method for receiving and determining information for a print cartridge of the printing device, as well as notifying, or informing, the user that the cartridge may not associate, or correspond, with the printing device.

Regarding claim 10 of the applicant, claim 8 of the patent discloses a print system for a printing device having a print cartridge and an identification reader. It also has a configuration-enabling system, or a feature-enabling system, to receive, retrieve information and enable the printing device with the first configuration, or feature, if the information corresponds.

Claim 8 of the patent also discloses a user authorization tag to communicate with the identification reader via wireless communication, which also includes a memory and is what claim 13 of the applicant, which depends from claim 10, also details.

Claim 8 of the patent also discloses an identification reader that includes a receiver to receive the information corresponding to the authorization of the user and is what claim 11 of the applicant, which depends from claim 10, also details.

Claim 8 of the patent also discloses a user authorization tag that includes information to retrieve information to enable the configuration-enabling system, or feature-enabling system, of the printing device and is what claim 14 of the applicant, which depends from claim 10, also details.

Regarding claim 15 of the applicant, claim 9 of the patent discloses a user authorization tag that includes a Uniform Resources Locator corresponding to the information adapted to enable the first configuration, or feature, of the printing device.

Regarding claim 16 of the applicant, claim 10 of the patent discloses a second print cartridge containing a print substance for printing on a print medium and a readable identification tag. This is installed after the first print cartridge is removed from the printing device.

Claim 10 of the patent also discloses the second print cartridge having an identification reader, but it would have been obvious to remove it because it still has a readable identification tag for providing the first information. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Regarding claim 18 of the applicant, claim 13 of the patent discloses a computer readable medium used with a printing device with logic for receiving information corresponding to the authorization of the user, retrieving the information and alter, which enables it too, the first configuration, or feature, of the printing device.

The patent also claims providing a user authorization tag with information to the authorization of the user within a proximity of the printing device, but it would have obvious that information is already received if the user desires to print a document. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Regarding claim 19 of the applicant, claim 14 of the patent discloses logic configured to access a web site and to retrieve the information to enable the first configuration, or feature, from the web site.

Regarding claim 20 of the applicant, claim 18 of the patent discloses logic configured to determine whether the identification information corresponding to a print cartridge is associated with the printing device, and if not, inform, or notify, the user.

The patent also claims receiving identification information corresponding to a print cartridge, but it would have obvious that information is already received if it is already determining the identification information regarding the print cartridge. See *In re Nelson*, 95 USPQ 82 (CCPA 1952).

Regarding claim 21 of the applicant, claim 15 of the patent discloses logic to determine if the authorizing information of the user is received, and if not, discontinue printing using the first configuration, or feature.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 18-19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Mazzagatte ('583).

Regarding claim 1, Mazzagatte ('583) discloses enabling features of a printing device once it receives information relating to the authorization of the user and the designation of the first feature of the printing device the user wants to enable, which is that printing is considered a feature of a printer that can be enabled (See Figure 1; Col. 8, Line 19-25). The printer retrieves this information and enables the authorized user to print the document with the first feature, which is at the chosen printer using the information retrieved (See Col. 9, Line 25-34).

Regarding claim 2, Mazzagatte ('583) discloses receiving the information to be printed (See Col. 9, Line 7-9) and enabling the printing device, or printer (See Figure 1, Element 30 and 50), to print the information using the first feature printing (See Col. 9, Line 25-34).

Regarding claim 3, Mazzagatte ('583) discloses providing a user authorization tag, or a unique identification information, corresponding to the authorization of the user (See Col. 8, Line 19-29). This received information is accomplished whenever the user authorization tag is in a proximity of the printing device, such as using a smart-card reader (See Col. 9, Line 46-55).

Regarding claim 4, Mazzagatte ('583) discloses if a smart-card is used for printing, the printer determines whether information relating the authorization of the user

is received, which validates the identity of the user (See Col. 9, Line 56-62). This process is discontinued, which includes the first feature or enabling the chosen printer, if the information relating to the authorization of the user is not received, or not validated (See Col. 9, Line 62-67).

Regarding claim 5, Mazzagatte ('583) discloses retrieving the information for enabling the first feature (See Col. 9, Line 25-34). This includes accessing a storage medium to the printing device for obtaining the identification information such as over the internet (See Col. 8, Line 37-40). The information is then retrieved, or downloaded, from the storage medium and adapted to enable the first feature of the printing device, which is submitted with the print job (See Col. 8, Line 40-42).

Regarding claim 6, Mazzagatte ('583) discloses the storage medium is a web site, which is over the internet, to download the information to the computer (See Col. 8, Line 37-42).

Regarding claim 7, Mazzagatte ('583) discloses the internet provides a storage medium, thus allowing the user to download the information to the computer and submit with the print job (See Col. 8, Line 37-42).

Regarding claim 8, Mazzagatte ('583) discloses the information to enable the first feature is stored by the printing device, or the print node, which can be a printer (See Col. 2, Line 46-50), upon receiving the data (See Col. 9, Line 8-10).

Regarding claim 18, the rationale provided in the rejection of claim 1 is incorporated herein. In addition, the method of claim 1 corresponds to the computer readable medium of claim 18 and additionally Mazzagatte ('583) discloses a computer

readable medium used with a printing device with logic (See Figure 1, Element 51; Col. 5, Line 66-Col. 6, Line 1).

Regarding claim 19, Mazzagatte ('583) discloses a logic configured to access a Web site, such as over the internet, and retrieve, or download, the information (See Col. 8, Line 37-42) to enable the first feature from the site (See Col. 9, Line 31-34).

Regarding claim 21, the rationale provided in the rejection of claim 4 is incorporated herein. In addition, the method of claim 4 corresponds to the computer readable medium of claim 21 and performs the steps disclosed.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte ('583) in view of Bolash ('041).

Regarding claim 9, Mazzagatte ('583) discloses identification information corresponding to a user for authorized printing (See Col. 8, Line 19-25).

Mazzagatte ('583) does not disclose receiving identification information corresponding to a print cartridge of the printing device, determine if it is associated with the printing device, and if not, notifying the user.

Bolash ('041) discloses receiving identification information corresponding to a print cartridge of the printing device and determines whether the identification

information corresponding to the print cartridge is associated with the printing device, such as determining if the appropriate type of print cartridge is installed (See Col. 4, Line 32-36). If this information does not correspond to the print cartridge of the printing device, an error message is displayed to notify the user the print cartridge is not associated with the printing device (See Col. 4, Line 43-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have information relating to a print cartridge for a printing device incorporated into Mazzagatte ('583) because whenever a user is authorized to print using the selected printer, if an error, such as incorrectly installing the wrong cartridge, occurred, the user is notified to make the proper changes to be able to print out the document.

Thus, claim 9 is rejected under 35 U.S.C. 103(a).

Regarding claim 20, the rationale provided in the rejection of claim 9 is incorporated herein. In addition, the method of claim 9 corresponds to the computer readable medium of claim 20 and performs the steps disclosed.

Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte ('583) in view of Hebert ('505).

Regarding claim 10, Mazzagatte ('583) discloses a print system (See Figure 1) with a printing device having a first print cartridge, which contains a print substance such as ink to print onto a print medium (See Col. 7, Line 28-33). The print system also has a feature-enabling system communicating with the printing device, such as allowing authorized users to print at a chosen printer (See Col. 9, Line 32-35). The feature-

enabling system is configured to receive information for authorization of a user with the designation of the first feature of the printing device the user wants to enable, which is that printing is considered a feature of a printer that can be enabled (See Figure 1; Col. 8, Line 19-25). The printer retrieves this information and enables the authorized user to print the document with the first feature using the information retrieved (See Col. 9, Line 25-34).

Mazzagatte ('583) does not disclose a printing device having an identification reader and a readable identification tag that is in the print cartridge to provide the first information. The identification reader receives the first information from the identification tag, and if it corresponds to the printing device, the reader enables the printing device to print.

Herbert ('505) discloses a printing device for using an identification tag, or a smart device (See Figure 1), on a cartridge (See Figure 2) to communicate with a sensor port (See Figure 1, Element 30) connected to the identification reader, or a microprocessor (See Figure 1, Element 10). The identification reader, or microprocessor, receives the first information, or data, from the identification tag, or the smart device, and if this data corresponds to the correctly and recognized by the microprocessor, it enables the printing device to print (See Col. 4, Line 9-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the an identification tag on a cartridge disclosed by Herbert ('505) and incorporated into the print system of Mazzagatte ('583) because this ensures the print cartridges are correctly used by the authorized user.

Thus, claim 10 is rejected under 35 U.S.C. 103(a).

Regarding claim 11, Mazzagatte ('583) discloses a print system having an identification reader that includes a receiver, such as a smart-card reader (See Figure 1, Element 15), which receives information relating to the authorization of the user using a wireless communication, such as inserting the smart card into the smart card reader (See Col. 8, Line 30-37).

Regarding claim 12, Mazzagatte ('583) discloses a print system having an identification reader that includes a means for receiving the information using a wireless communication, such as inserting the smart-card into the smart-card reader (See Col. 9, Line 52-55).

Regarding claim 13, Mazzagatte ('583) discloses a print system having a user authorization tag, or a unique identification information contained on a smart-card, used to communicate with the identification reader, such as a smart-card reader (See Col. 9, Line 52-55). When obtained, the user authorization tag has the information stored in a memory located within the smart-card in digital form which is supplied to the computer through the smart-card interface (See Col. 9, Line 46-55).

Regarding claim 14, Mazzagatte ('583) discloses a print system with a user authorization tag, or a unique identification information, that includes data for the feature-enabling system, or smart-card reader, to retrieve the information (See Col. 9, Line 52-55) and enable the first feature of the printing device, which is what printer to output the information to (See Col. 9, Line 31-34).

Regarding claim 15, Mazzagatte ('583) discloses a print system where the user authorization tag, or a unique identification information, includes a uniform resources locator, such as an internet site, corresponding to the information to submit with the print job (See Col. 8, Line 37-42) and enable the first feature of the printing device, such as what printer to output the information to (See Col. 9, Line 31-34).

Regarding claim 16, Mazzagatte ('583) discloses a print system (See Figure 1) with a printing device having a first print cartridge, which contains a print substance such as ink to print onto a print medium (See Col. 7, Line 28-33).

Mazzagatte ('583) does not disclose having a second print cartridge, which is installed in the printing device after the first cartridge is removed, with a readable identification tag for providing the first information.

Herbert ('505) discloses a second print cartridge is needed after the ink supply of the first is empty (See Col. 3, Line 60-62). The second print cartridge also contains a readable identification tag for providing the first information, or data, correctly (Col. 3, Line 67-Col. 4, Line 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have the an identification tag on a second cartridge disclosed by Herbert ('505) and incorporated into the print system of Mazzagatte ('583) because this ensures that more print cartridges are correctly used by the authorized user after one is removed from the printing device.

Thus, claim 16 is rejected under 35 U.S.C. 103(a).

Regarding claim 17, Mazzagatte ('583) discloses a print system (See Figure 1).

Mazzagatte ('583) does not disclose the first feature can be a half-toning algorithm, a font, a digital signature or a photo algorithm.

It would have been obvious to have the user, once authorized, print out a document with a first feature being font because it was the type chosen in the application prior to being processed. So, the font being printed is the same that was chosen before information was being received corresponding to the authorization of the user.

Thus, claim 17 is rejected under 35 U.S.C. 103(a).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is: Kobayashi ('238) and Chapman (Pub. # 20020067498).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on Monday through Friday 8 A.M. - 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent Rudolph  
Examiner  
Art Unit 2624



MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
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